

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 1-22 were pending. By the present response, claims 1, 5 and 14 have been amended and claims 23-34 have been added. Thus, upon entry of the present response, claims 1-34 remain pending and await further consideration on the merits.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims and the specification, paragraphs [0017] to [0019], Figures 1A-1D, 2 and 5A-5G.

DRAWINGS

At paragraphs 2 and 3 of the Office Action, the drawings were objected to for the noted reference numerals. Applicant has amended the specification, paragraph [0017] to correctly reference 248 as the second side in Figure 2. Also, label 534 has been added to Figures 5a – 5g consistent with paragraph [0019] of the specification to indicate the frame. Applicant respectfully requests reconsideration of this objection.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 1-3, 5, 6, 11, 12, 14, 15, and 18-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,615,871 to Kleinhenn (hereafter

"*Kleinhen*") in view of U.S. Patent No. 4,083,551 to St. Denis (hereafter "*St. Denis*") on the grounds set forth in paragraph 4 of the Official Action.

Claims 1, 7-10, 13, 16 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,099,225 to Allan et al. (hereafter "*Allan et al.*") in view of *Kleinhen* and further in view of *St. Denis* on the grounds set forth in paragraph 5 of the Official Action.

For at least the reasons noted below, these rejections should be withdrawn.

The present invention is directed to handling of sheet material in a booklet maker. As shown in Figures 1A–1D, exemplary embodiments of the booklet maker include a pivotable saddle 102 and a transfer arm 104 transferring from a first position to a second position. The transfer device 104 is substantially represented as an arm in the embodiment shown with a fixed clamping component 120 and a displaceable clamping component 118. The transferring device moves from a first position to a second position to move a sheet of material 116 across the collecting device 102 so that portions of the folded sheet are on the supporting sides 136, 138 of the collecting device. The transfer device 104 moves in a non-linear path to place the sheet material 116 over the supporting edge 126 of the collecting device 102 and, optionally, returns to the original position to transfer a second sheet. The transfer device 104 clamps the sheet to the transferring device during the transfer operation with the fixed clamping component 120 and the displaceable clamping component 118.

Further, the collecting device 102 has a collecting drive supported by member 156. In a first position, the collecting device 102 forces the member 156 to a disengaged position in which the drive elements (shown in Figure 2) are spaced

apart from the supporting side of the collecting device 102. When the collecting device pivots, the member 156 is moved to an engaged position by the operation of the spring.

The above exemplary features and operation are generally embodied in applicant's independent claims at issue here. Independent claim 1 recites that a booklet maker comprises, *inter alia*, a pivotable collecting including two supporting sides formed with a saddle shape and a reciprocating transferring device. The transferring device includes a displaceable clamping component. The transferring device reciprocates along a non-linear path to deliver a folded sheet material to the collecting device. The collecting device pivots to receive the folded sheet material from the transferring device such that different portions of the folded sheet material are supported by different sides of the two supporting sides of the collecting device. Independent claim 14 recites that a method for making booklets comprises the steps, *inter alia*, clamping a folded sheet material with a reciprocating transferring device, delivering the folded sheet material to a pivotable collecting device along an arc established by movement of the transferring device, the folded sheet material being deposited over a supporting edge of the collecting device such that a fold of the folded sheet material was received by the supporting edge, and pivoting the collecting device such that different portions of the folded sheet material are received by different supporting sides of the collecting device.

The rejection based on the hypothetical combination of the disclosures in *Kleinhenn* and *St. Denis* is improper because the Official Action has not established a *prima facie* case of obviousness as required by MPEP §§2143-2143.03. There are three basic criteria to establish a *prima facie* case of obviousness. First there must

be a suggestion or motivation to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success for the proposed modification of combination. Third, the references must teach or suggest all of the claim limitations. Here, the rejection over *Kleinhen* in view of *St. Denis* is improper because the references do not teach or suggest all of the claim limitations.

Here, applicant's independent claims recite that the booklet maker comprises, *inter alia*, a reciprocating transferring device that reciprocates along a non-linear path (claim 1), and recite that a method clamps a folded sheet with a reciprocating transferring device (claim 14). The disclosure in *Kleinhen*, and the disclosure in *St. Denis* are quite different.

For example, the Official Action notes that *Kleinhen* has a rotatable transferring device 40. However, the rotatable transferring device of *Kleinhen* rotates only in a first direction (e.g., clockwise as indicated by the arrow in Figure 5). The rotatable transferring device 40 of *Kleinhen* rotates in the one direction for proper operation of, for example, the internal drives and cams operating the gripper assembly 80 and the folder assembly 106.

In contrast, applicant's independent claims at issue here claim a reciprocating transferring device in which the transferring device moves in a first direction along a non-linear path or arc and returns to a starting position along the same path or arc.

The disclosure in *St. Denis* does not solve this noted deficiency in *Kleinhen* and the proposed combination does not, therefore, contain each and every limitation of the independent claims at issue here.

In addition, the disclosure in *Kleinhen* does not include a pivotable collecting device. See, for example, the Official Action at page 5. The Official Action then

relies upon the disclosure in *St. Denis* of a collecting device 14 which displaces by pivoting around a Y axis. However, applicant respectfully notes that there is no such pivoting device in the disclosure of *St. Denis*. Rather, *St. Denis* explicitly states that he has a **fixed saddle 14**. See column 3, line 21.

Accordingly, applicant respectfully asserts that the combination of the disclosure in *Kleinhen* with the disclosed fixed saddle 14 of *St. Denis* does not overcome the noted deficiency in *Kleinhen*. In other words, the disclosure in *Kleinhen* lacks a pivotable collecting device. *St. Denis* discloses a fixed saddle or collecting device. Accordingly, the combination of these cited references cannot combine to contain each and every element of applicant's claimed booklet maker and method of making booklets.

The proposed combination of the disclosures in *Kleinhen* and *St. Denis* do not contain each and every limitation of the independent claims at issue here. Therefore, the rejection of independent claims 1 and 14 are improper because a *prima facie* case of obviousness has not been established. Withdrawal of these rejections is respectfully requested.

With respect to the rejection over the combination of *Kleinhen* and *Allan et al.* and *St. Denis*, applicant respectfully asserts that the disclosure in *St. Denis* of a fixed collecting device or saddle does not overcome the noted deficiency in the Official Action (see page 6, paragraph 4) that *Allan et al.* as modified by *Kleinhen* does not disclose a pivotable collecting device. For at least this reason, this rejection is also improper under MPEP §2143 and should be withdrawn.

NEW CLAIMS

Applicant has added new claims 23-34 to include additional features of applicant's booklet maker and method of making booklets. Notably, applicant has included features and description of the operation of the transferring device and the collecting device as dependent claims. Accordingly, these claims distinguish over the cited combination of references for at least the same reason as the independent claims from which they depend.

ALLOWABLE SUBJECT MATTER

Applicant notes with appreciation the indication that claims 21-22 are allowed and the indication that claim 4 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. By the present response, claims 23-26 have been added dependent from allowed independent claim 21. Thus, these claims are also allowable for at least the same reason as independent claim 21.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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